



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 693,746	10/20/2000	David E. Lowery	6297.1cp-PUJ-0295	7494

7590 03/15/2002

Mark J Rosen
Woodcock Washburn Kurtz Maciewicz & Norris LLP
One Liberty Place 46th Floor
Philadelphia, PA 19103

EXAMINER

MURPHY, JOSEPH F

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 03/15/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,746

Applicant(s)

LOWERY ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I-XI. Claims 1-27, drawn to an isolated nucleic acid, a vector, a host cell, and a method of producing a polypeptide, comprising ONE of the following nucleic acid sequences: SEQ ID NO: 1, 3, 5, 9, 11, 13, 15, 17, 19, 21 or 23, classified in class 435, subclass 69.1.

XII-XXII. Claims 28-33, drawn to an isolated polypeptide with an amino acid sequence as set forth in ONE of the following: SEQ ID NO: 2, 4, 6, 10, 12, 14, 16, 18, 20, 22, or 24, classified in class 530, subclass 350.

XXIII-XXXIV. Claims 34-36, drawn to an antibody which binds an isolated polypeptide with an amino acid sequence as set forth in ONE of the following: SEQ ID NO: 2, 4, 6, 10, 12, 14, 16, 18, 20, 22, or 24, classified in class 530, subclass 387.1.

XXXV-XLV. Claim 37, drawn to a method of inducing an immune response in a mammal by administration of an isolated polypeptide with an amino acid sequence as set forth in ONE of the following: SEQ ID NO: 2, 4, 6, 10, 12, 14, 16, 18, 20, 22, or 24, classified in class 514, subclass 2.

XLVI-LVI. Claims 38-40, 43-45, drawn to a method for identifying a compound which binds an isolated polypeptide with an amino acid sequence as set forth in ONE of the following: SEQ ID NO: 2, 4, 6, 10, 12, 14, 16, 18, 20, 22, or 24, classified in class 435, subclass 7.2.

Art Unit: 1646

LVII-LXVII. Claims 41-42, drawn to a method for identifying a compound which binds a

nucleic acid molecule comprising ONE of the following nucleic acid sequences:

SEQ ID NO: 1, 3, 5, 9, 11, 13, 15, 17, 19, 21 or 23, classified in class 204,

subclass 456.

LXVII. Claim 46, 47-49, drawn to a method for identifying a modulator of binding

between a DmGPCR1 and ONE of SEQ ID NO: 25-33, classified in class 435,

subclass 7.8.

LXIX. Claim 46, 50-54, drawn to a method for identifying a modulator of binding

between a DmGPCR4 and ONE of SEQ ID NO: 34-37, classified in class 435,

subclass 7.8.

LXX-XCI. Claims 46, 55, drawn to a method for identifying a modulator of binding

between a DmGPCR6a and ONE of SEQ ID NO: 38-59, classified in class 435,

subclass 7.8.

XCII-CLXXXIX. Claim 46, 56, drawn to a method for identifying a modulator of binding

between a DmGPCR6aL and ONE of SEQ ID NO: 60-157, classified in class

435, subclass 7.8.

CXC- CCLXXXVII. Claim 46, 57-58, drawn to a method for identifying a modulator of

binding between a DmGPCR6bL and ONE of SEQ ID NO: 60-157, classified in

class 435, subclass 7.8.

CCLXXXVIII. Claim 46, 59, drawn to a method for identifying a modulator of binding

between a DmGPCR9 and SEQ ID NO: 157, classified in class 435, subclass 7.8.

CCLXXXIX. Claim 60, drawn to a compound, classified in class 530, subclass 300.

CCXC-CCC. Claims 61-62, drawn to a method of identifying a homolog of ONE of the following nucleic acid sequences: SEQ ID NO: 1, 3, 5, 9, 11, 13, 15, 17, 19, 21 or 23, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XI, XII-XXII, XXIII-XXXIV are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function, and each has an independent utility, that is distinct for each invention which cannot be exchanged.

Inventions XXXV-XLV, XLVI-LVI, LVII-LXVII, LXVII, LXIX, LXX-XCI, XCII-CLXXXIX, CXC-CCLXXXVII, CCLXXXVIII, CCXC-CCC are independent and distinct, each from the other, because the methods are practiced with materially different starting materials, have materially different process steps, and are for materially different purposes.

Inventions I-XI and LVII-LXVII, CCXC-CCC are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of inventions I-XI can be used for the production of protein.

Inventions XII-XXII and XXV-XLV, XLVI-LVI, LXVII, LXIX, LXX-XCI, XCII-CLXXXIX, CXC-CCLXXXVII, CCLXXXVIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different

product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of inventions XII-XXII can be used for the production of antibody.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Art Unit: 1646


Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
March 12, 2002


DAVID S. ROMEO
PATENT EXAMINER